

ESTTA Tracking number: **ESTTA69235**

Filing date: **03/03/2006**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Smartbox Moving & Storage, LLC
Granted to Date of previous extension	03/15/2006
Address	2100 Dabney Road Richmond, VA 23230 UNITED STATES
Correspondence information	S. Brian Farmer Attorney Hirschler Fleischer 701 East Byrd Street Richmond, VA 23219 UNITED STATES bfarmer@hf-law.com, rhenley@hf-law.com Phone:804-771-9500

Applicant Information

Application No	78560422	Publication date	11/15/2005
Opposition Filing Date	03/03/2006	Opposition Period Ends	03/15/2006
Applicant	A Smart Move L.L.C. 5350 S. Roslyn Street Suite 380 Greenwood Village, CO 80111 UNITED STATES		

Goods/Services Affected by Opposition

Class 020. First Use: 2004/08/01 First Use In Commerce: 2005/01/01
All goods and services in the class are opposed, namely: Non-metal Container for the storage and transportation of goods

Attachments	Notice of Opposition.pdf (7 pages)
Signature	/sbrianfarmer/
Name	S. Brian Farmer
Date	03/03/2006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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SMARTBOX MOVING & STORAGE, L.L.C.,)	
)	
Opposer,)	
)	OPPOSITION NUMBER
v.)	
)	
A SMART MOVE, L.L.C.,)	
)	
Applicant)	_____

NOTICE OF OPPOSITION

Smartbox Moving & Storage, L.L.C., a Virginia corporation, having its principal place of business at 2100 Dabney Road, Richmond, Virginia 23230 ("Opposer"), believes that it will be damaged by the registration of the proposed mark SMARTVAULT, which is the subject of application Serial No. 78/560,422, covering "non-metal container[sic] for the storage and transportation of goods" in International Class 20 ("Applicant's Claimed Goods"), owned by A Smart Move, L.L.C. ("Applicant"). Opposer hereby opposes registration of the mark SMARTVAULT under Sections 2(d) and 13 of the Trademark Act of July 5, 1946 (the "Lanham Act"), 15 U.S.C. §§ 1052(d) and 1063.

As grounds for opposition, Opposer alleges that:

The Opposer and Its SMARTBOX Marks

1. Based in Richmond, Virginia, Opposer is a leading nationwide provider of portable storage and moving services to residential and commercial customers through its network of franchise locations covering over 40 markets throughout the United States.

2. Opposer is the owner of all right, title and interest in and to the SMARTBOX mark in connection with arranging for the pickup, delivery, storage, and transportation of containers involved with personal and business belongings ("Opposer's Services"), based on its use of the mark with Opposer's Services since at least as early as January 2003.

3. In addition to its rights arising from common law, Opposer is the owner of all right, title, and interest in and to the federal registration for the trademark SMARTBOX & Design, Registration Number 2,864,385, registered July 20, 2004, and first used in commerce at least as early as January 2003 for "arranging for the pickup, delivery, storage, and transportation of containers involved with personal and business belongings."

4. The registration for SMARTBOX & Design (Reg. No. 2,864,385) is valid and subsisting and in full force and effect, and constitutes *prima facie* evidence of, *inter alia*, Opposer's exclusive right to use the mark in connection with the services specified in the registration.

5. Opposer adopted and began using the marks SMARTBOX and SMARTBOX & Design, Reg. No. 2,864,385 (collectively, the "SMARTBOX Marks"), in connection with Opposer's Services at least as early as January 2003, and has continuously used the SMARTBOX Marks in connection with Opposer's Services in interstate commerce in the United States since that time.

6. As a result of the widespread and extensive use by Opposer of the SMARTBOX Marks, the SMARTBOX Marks have become extremely valuable to Opposer in connection with the offering and sale of Opposer's Services. The SMARTBOX Marks identify and distinguish Opposer's Services from the goods and services of other persons and businesses, represent the goodwill of Opposer's business, and are well-known.

7. Opposer's SMARTBOX Marks are inherently distinctive and have acquired substantial distinctiveness. Opposer has spent significant amounts of money to advertise and promote Opposer's Services in connection with the SMARTBOX Marks, resulting in significant revenues.

The Applicant and Its SMARTVAULT Mark

8. Upon information and belief, Applicant is a Colorado corporation, formed in October 2004, which provides transportation and shipping services to residential and commercial customers, including arranging for the pickup, delivery, storage, and transportation of containers involved with personal and business belongings ("Applicant's Services").

9. Upon information and belief, Applicant only uses the SMARTVAULT mark in connection with Applicant's Services. Upon information and belief, Applicant has not sold Applicant's Claimed Goods in trade and has not transported such claimed goods in connection with SMARTVAULT, independent from the rendering of Applicant's Services.

10. Upon information and belief, Applicant has not filed an application to register the mark SMARTVAULT in connection with Applicant's Services because of the likelihood that the U.S. Patent and Trademark Office ("Trademark Office") would refuse registration of such mark due to the substantial similarity with Opposer's prior registration of SMARTBOX & Design (Reg. No. 2,864,385) for use in connection with virtually identical services.

11. On February 3, 2005, Applicant instead filed an application for federal registration of the mark SMARTVAULT, proposed to be used in connection with Applicant's Claimed Goods under Section 1(a) of the Lanham Act, 15 U.S.C. § 1051(a).

12. The declaration filed with the SMARTVAULT application claims that the SMARTVAULT mark was in use in connection with Applicant's Claimed Goods at the time that

the application was filed. The declaration further claimed that use of the SMARTVAULT Mark began on August 1, 2004 and that use of such mark in commerce began on January 1, 2005, which is two years after Opposer commenced use of its SMARTBOX Marks in connection with virtually identical services to those of Applicant.

13. Upon information and belief, when Applicant signed the declaration and filed the application, it knew or should have known that, although the SMARTVAULT mark was used in connection with Applicant's Services, the mark had never been used in connection with Applicant's Claimed Goods in trade at any time up to and including the time when Applicant filed the application.

14. Upon information and belief, Applicant knew or should have known that representations regarding use in connection with Applicant's Claimed Goods in the application were false and that such representations would induce the Trademark Office to grant registration of the SMARTVAULT mark.

15. Upon information and belief, the Trademark Office approved the SMARTVAULT mark for registration and allowed it for publication upon reasonable reliance on the truth of the false representation regarding the use of the mark in connection with Applicant's Claimed Goods.

16. The SMARTVAULT application was published for opposition in the *Official Gazette* of November 15, 2005. The opposition period was set to expire on December 15, 2005. Opposer timely filed requests for extensions of time to oppose SMARTVAULT through March 15, 2006.

COUNT ONE

Confusing Similarity

17. Opposer restates and realleges the allegations of Paragraphs 1-16 as if fully set forth herein.

18. Through Opposer's adoption and continuous use of the SMARTBOX mark since at least as early as January 2003 and by virtue of the rights afforded the SMARTBOX & Design mark through ownership of the federal registration listed in Paragraph 3 above, Opposer established rights in the SMARTBOX mark that, upon information and belief, predate any right upon which Applicant can rely with respect to SMARTVAULT.

19. Opposer's rights to the SMARTBOX Marks in connection with Opposer's Services are therefore superior to Applicant's rights in SMARTVAULT.

20. Opposer's SMARTBOX Marks are very similar in terms of appearance, sound and meaning to the SMARTVAULT mark; Applicant's Claimed Goods and Opposer's Services are closely related; Applicant's Services and Opposer's Services are virtually identical; and, upon information and belief, Applicant's Claimed Goods (if any), Applicant's Services and Opposer's Services are offered through the same, substantially the same or related channels of trade to the same, substantially the same, or related classes of purchasers.

21. Opposer will be damaged by the registration of SMARTVAULT under Section 13 of the Lanham Act, 15 U.S.C. § 1063, because the SMARTVAULT mark is likely to cause confusion, mistake and/or deception as to the source, origin, sponsorship or affiliation of goods and services under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

COUNT TWO

Application Is Void Ab Initio

22. Opposer restates and realleges the allegations of Paragraphs 1-21 as if fully set forth herein.

23. Applicant has not used SMARTVAULT in connection with Applicant's Claimed Goods in commerce, as required under Sections 1(a)(1) and 45 of the Lanham Act, 15 U.S.C. §§ 1051(a)(1), 1127.

24. Because Applicant has not used the SMARTVAULT mark in connection with Applicant's Claimed Goods in trade as set forth in its application, Applicant negligently or intentionally misled the Trademark Office, and Applicant is therefore not entitled to registration.

25. Opposer will be damaged by the registration of SMARTVAULT under Section 13 of the Lanham Act, 15 U.S.C. § 1063, for the reasons stated above in Paragraph 21.

PRAYER FOR RELIEF

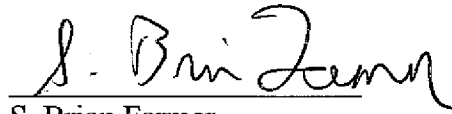
25. WHEREFORE, Opposer prays this opposition be sustained and that Application Serial No. 78/560,422 be refused registration.

26. In accordance with 37 C.F.R. § 2.101(d)(1), Opposer requests that the \$300 required fee and any additional fees be charged to the deposit account of Hirschler Fleischer, P.C., Account No. 501335.

Respectfully submitted,

HIRSCHLER FLEISCHER, P.C.

Date: March 1, 2006

A handwritten signature in dark ink, appearing to read "S. Brian Farmer". The signature is written in a cursive style with a horizontal line underneath the name.

S. Brian Farmer

Robert P. Henley

HIRSCHLER FLEISCHER,

a Virginia professional corporation

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